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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,784	09/15/2000	Malcolm L. Gefter	IMI-044DV3CN	3152

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[REDACTED] EXAMINER

TURNER, SHARON L

ART UNIT	PAPER NUMBER
1647	

DATE MAILED: 02/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/662,784	Applicant(s) Gefter et al.
Examiner Sharon L. Turner, Ph.D.	Art Unit 1647



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 9-15-00
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.
- 4) Claim(s) 95-110 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims 95-110 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) Other: _____

Art Unit: 1647

DETAILED ACTION

Election/Restriction

1. The preliminary amendment filed 9-15-00 has been entered and fully considered.
2. Claims 1-94 are canceled. Claims 95-113 are pending.

Improper Markush

3. Prior to setting forth the restriction requirement, it is pointed out that applicants have presented instant claims in improper Markush format, see Ex parte Markush, 1925 C.D. 126, In re Weber, 198 USPQ 334 and MPEP 803.02 and 806.04. The claims are improperly set forth as the genus claims encompassing multiple nucleic acids and peptides, as identified and claimed, fail to share the characteristics of a genus, i.e., a common utility and a substantial structural feature essential to the disclosed utility. Alternatively, the claims define multiple structurally distinct compounds capable of different use, with different modes of operation, different function and different effects. A reference against one of the claimed components or methods would not be a reference against the other. Therefore, the restriction will be set forth for each of the various groups, irrespective of the improper format of the claims, because the claims define inventions which are not proper species.

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I-IV. Claims 95-96, 101-104 in part, drawn to distinct therapeutic compositions wherein the compositions comprise respectively SEQ ID Nos:6, 8, 10 and 16 and

Art Unit: 1647

at least part of a sequence with an epitope in common with one of SEQ ID Nos:6, 8, 10 or 16, classified in class 530, subclass 300.

V-VIII. Claims 97-100 in part, drawn to distinct therapeutic compositions wherein the compositions further comprise a second isolated polypeptide different from the first, having SEQ ID Nos:2, 4, 11 or 12 and having at least a part of a sequence with an epitope in common with one of SEQ ID Nos: 2, 4, 11 or 12, classified in class 530, subclass 300.

IX-XII. Claim 105 in part, drawn to methods of treating with the respective distinct therapeutic compositions of Groups I-IV, classified in class 514, subclass 2.

XIII-XVII. Claims 106 in part, drawn to methods of treating with the respective distinct therapeutic compositions of Groups V-VIII, classified in class 514, subclass 2.

XVIII-XXII.. Claim 107 in part, drawn to a method of detecting sensitivity with the respective distinct compositions of Groups I-IV, classified in class 436, subclass 500.

XXIII-XXVII. Claims 108-110 in part, drawn to distinct nucleic acid compositions respectively encoding the polypeptides of Groups I-IV, classified in class 536, subclass 23.1.

5. The inventions are distinct, each from the other because of the following reasons:

6. Inventions I-VIII and XXIII-XXVII are related as products. The products are distinct because they are comprised of unique polypeptide amino acid sequences and unique polynucleotide nucleic acid sequences which each differ in structure, function and search.

Art Unit: 1647

7. Inventions IX-XXII are related as processes. The processes are distinct because of their different steps, different product reagents, different effects and outcomes.

8. Inventions I-IV and V-VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions I-VIII each has separate utility such as in a method of making a distinct antibody. See MPEP § 806.05(d).

9. Because these inventions are distinct for the reasons given above and the search required for any one of the Groups is not required for any other Group, restriction for examination purposes as indicated is proper.

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Further it is noted that in order to be fully responsive applicant's must clearly indicate the SEQ ID NO's within the distinct combination/subcombinations of the elected Groups to which the search will be limited, and the claims readable thereon including any subsequently added claims.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

Art Unit: 1647

named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

13. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Turner, Ph.D. whose telephone number is (703) 308-0056. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.

Sharon L. Turner, Ph.D.
February 5, 2002

Gary L. Kunz
GARY L. KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600